

REMARKS

Applicant gratefully acknowledges the telephone interview with the Examiner conducted on January 4, 2007. Applicant has attempted to address the issues raised by the Examiner in the interview with this response.

Applicant has considered and studied the Office Action dated September 7, 2006. Claims 1-22 are pending. Claims 1-22 are amended. Claims 1, 10 and 19 are independent claims. No new matter has been added as the amendments have support in the specification as originally filed.

It is submitted that the application, as amended is in condition for allowance. Reconsideration and reexamination are respectfully requested.

Interview with Examiner

During the interview on January 4, 2007, the various portions of the Schuster reference that are discussed herein were presented to the Examiner. Although the Examiner indicated that further analysis of Schuster would be required, the Examiner appeared to agree that Schuster does primarily disclose embodiments in which commercial messages are transmitted to and displayed on a terminal in the "off-hook" condition, or during a telephone call. The Examiner asserted that the broad term "information" as used in the claims should be clarified with regard to "information" that is transmitted to and displayed by a terminal in the "on-hook" status and "information" that is transmitted to and displayed by a terminal in the "off-hook" status and further asserted the disclosure of "Caller ID" in column 1 of the Schuster reference as an example of "information" transmitted to and displayed by a terminal that is in the "on-hook" status. The Examiner further commented that claims 1-18 recite an "apparatus" in the preamble but elements that are inconsistent with an "apparatus."

Amendments to the Claims

Claims 2-9, 11-18 and 20-22 have been amended to correct typographical or grammatical errors or to more clearly disclose the invention. It is respectfully submitted

that the amendments have support in the application as originally filed and are not related to patentability.

Objections to Claims

Although no formal objection to the claims was asserted in the Office action, claims 1-18 have been amended to replace the word "apparatus" with the word "system" in the preamble to address a concern indicated by the Examiner during the telephone interview on January 4, 2007.

§ 103 Rejections

Claims 1-22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schuster et al. ("Schuster" U.S. Pat. No. 6,937,699). Applicant respectfully disagrees with the Examiner's interpretation of Schuster and respectfully traverses the rejection.

It is respectfully noted that the Federal Circuit has provided that an Examiner must establish a case of prima facie obviousness. Otherwise the rejection is incorrect and must be overturned. As the court stated in In re Rijkaert, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993):

"In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. 'A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.' If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned." (citations omitted.)

It is well-settled that a reference must provide some motivation or reason for one skilled in the art (working without the benefit of the applicants' specification) to make the necessary changes in the disclosed device. The mere fact that a reference may be modified in the direction of the claimed invention does not make the modification obvious unless the reference expressly or impliedly teaches or suggests the desirability of the modification. In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984); Ex parte

Clapp, 227 USPQ 972, 973 (Bd. App. 1985); Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. App. 1984).

In re Bozek, 163 USPQ 545 does recite that one may use common sense, but this quote is in reference to determining if art is "non-analogous" and whether it can be combined with a second reference. However, the Bozek case recites, one section above the common sense section, that "we have said many times that a reference disclosure must be evaluated for all that it fairly suggests and not only for what is indicated as preferred" (emphasis in original).

It is respectfully noted that the present invention is directed to a display apparatus for receiving various information and displaying the information on a display of a network terminal, the information sent from an information server when the network terminal has an on-hook status with the network terminal connected to a local network and the local network connected to an external network by a gateway system. It is further respectfully noted that the information server checks the on-hook status of the terminal before sending information to be displayed the network terminal. Moreover, it is respectfully noted that the network terminal sends call status information included in a call setup message between the network terminal and gateway system to the information server and the information server judges the call status of the network terminal using the call status information.

It is respectfully noted that the Examiner asserts, at paragraph 5 on page 3 of the Office action, that Schuster "does not clearly teach the limitation 'determining status of each terminal based on call status information included in the call setup information exchanged between each terminal and the gateway system, transmitting the information to each terminal in an on-hook status thereof after checking the on-hook status of the terminal, and displaying the information on a display unit of the terminal' but it is suggested." It is further respectfully noted that the Examiner also asserts that Schuster "does provide the environment wherein information is sent from an information server to a terminal which is capable of displaying the **terminal** regardless of the terminal being on-hook or off-hook," (emphasis added) specifically citing "col. 16, line 62 – col. 17, line 5, and that Schuster "further provides an embodiment wherein a user is provided with a

commercial message when connection is made to a telephony connection server in order to make a connection to another party and be in an 'off-hook' status," specifically citing col. 17, lines 27-39. Moreover, it is respectfully noted that the Examiner asserts "it is taught by Schuster ... broadly to display information retrieved from an information server when in any condition" and that "the ability to display information when the user terminal is in an 'on-hook' condition is deemed an obvious variation of Schuster."

As a first preliminary matter, it is assumed that the Examiner meant to use the word "information" instead of the word "terminal" with respect to the assertion of "a terminal which is capable of displaying the **terminal** regardless of the terminal being on-hook or off-hook." As second preliminary matter, Applicant respectfully requests clarification of the Examiner's assertions with regard to Schuster given that the Examiner first asserts that "it is suggested" with regard to the limitations that the Examiner admits Schuster "does not clearly teach" and then asserts that that the limitation is "taught broadly" but goes on to assert that the limitation "is deemed and obvious variation of Schuster." Applicant respectfully requests that the Examiner indicate whether the assertion is that Schuster teaches the limitations or the assertion is that the limitations would require modification of the Schuster invention.

Notwithstanding the abovementioned preliminary matters, Applicant respectfully disagrees with the Examiner's interpretation of Schuster. It is respectfully noted that the portions of Schuster cited by the Examiner fail to disclose or suggest displaying the information "regardless of the terminal being on-hook or off-hook" as asserted by the Examiner.

With regard to the portion of Schuster at col. 16, line 62 to col. 17, line 5 cited by the Examiner, it is respectfully noted that the disclosure is merely that "commercial messages" that include "image and/or text data" is "transported to the data network telephones 208, 216 for display on the telephone display device 116" and that the "commercial messages are stored in the commercial message database 122 ... managed by the commercial message server 120." With regard to the portion of Schuster at col. 17, ll. 27-39 cited by the Examiner, it is respectfully noted that the disclosure is merely that "[t]he telephony connection server 150 sends the request to

the data network telephone 218 [of] User B" and "[a]fter the receipt of the request, the telephony connection server 150 sends the connection information 270 to the commercial message server" with the "commercial message server 120 ... then ... sending User B's commercial messages."

It is respectfully submitted that the neither of the cited portions identifies any "on-hook" or "off-hook" status of the "telephones 206, 216" or suggests that the display of the "commercial messages" is "regardless of the terminal being on-hook or off-hook." It is further respectfully submitted that several portions of Schuster not cited by the Examiner make it clear that the display of the information is when a terminal is in the "off-hook" state.

The Examiner's attention is first directed to the disclosure at col. 3, line 64, to col. 4, line 11 of Schuster. It is respectfully noted that the disclosure is of an embodiment where "a request is sent to initiate a telephone call between a first network telephone and a second network telephone" and "at least one commercial message is sent to the first data network telephone ... displayed on the display screen of the first data network telephone." It is respectfully submitted that the "first data network telephone" must be in an "off-hook" state in order to "initiate a telephone call" and, therefore, the disclosure of displaying "at least one commercial message" on the "display screen of the first data network telephone" is related to the display of information when a terminal is in the "off-hook" state.

The Examiner's attention is next directed to the disclosure at col. 4, ll. 12-21 of Schuster. It is respectfully noted that the disclosure is of an embodiment where "a communication is established with a telephone service provider" and "[a]t least one commercial message is then sent ... and the commercial message is displayed at the data network telephone." It is respectfully submitted that once "communication is established," the "data network telephone" is in an "off-hook" state and, therefore, the disclosure of "the commercial message is displayed at the data network telephone" is related to the display of information when a terminal is in the "off-hook" state.

The Examiner's attention is next directed to the disclosure at col. 12, ll. 17-26 of Schuster. It is respectfully noted that the disclosure is of a "display data function 251" that displays "the name(s) and user identifier(s) of the other party(-ies) to the call, the status of the telephone call, billing information" and that "may also provide access to the display interface 262 for the display of commercial messages sent from the commercial message server 120." It is respectfully submitted that "the name(s) and user identifier(s) of the other party(-ies) to the call, the status of the telephone call, billing information" implies that a call is in progress or, in other words, that "the display of commercial messages sent from the commercial message server 120" is related to the display of information when a terminal is in the "off-hook" state.

The Examiner's attention is next directed to col. 17, ll. 15-67. It is respectfully noted that the disclosure is, with respect to FIG. 3A, of a telephone call initiated "from User A's data network telephone 208 to the data network telephone 218 belonging to User B, whereby "User A begins the telephone call by dialing User B's user identifier" and "the merchant's commercial message 272 received from the commercial message server 120 ... is extracted from the message body of the response and displayed on the display 116." It is further respectfully noted that the disclosure indicates "[t]he displayed commercial message 316 may include a display button 328" that "[w]hen pressed, the display button 328 initiates a speed dial connection 290, at the termination of the present telephone call" or "may also initiate the telephone call immediately because multiple communication channels may be established during a telephone call."

It is respectfully submitted that "display 116" on which "the merchant's commercial message 272 received from the commercial message server 120" is displayed is, per FIG. 3A, the display of "User A" and, since the telephone is initiated "from User A's data network telephone 208," User A is in an "off-hook" state and the disclosure is, therefore, related to the display of information when a terminal is in the "off-hook" state. It is further respectfully submitted that there is no disclosure of any display of "the merchant's commercial message 272 received from the commercial message server 120" on the display of User B.

The Examiner's attention is next directed to col. 18, line 14, to col. 20, line 29. It is respectfully noted that the disclosure is, with respect to FIGS. 3B, 4A and 4B, of alternate methods for displaying a commercial message that are disclosed with respect to the disclosure related to FIG. 3A and, therefore, also are related to the display of information when a terminal is in the "off-hook" state. It is further respectfully noted that, with respect to FIG. 4A, the disclosure is that "one advantage of the embodiment of FIG. 4A is that the communication of commercial messages may continue throughout the time of the telephone call, thereby further supporting that the disclosure is related to the display of information when a terminal is in the "off-hook" state.

The Examiner's attention is next directed to col. 20, line 30, to col. 21, line 42. It is respectfully noted that the disclosure is, with respect to FIGS. 5A and 5B, the first disclosure of any display of the "commercial messages" to "User B's data network telephone 218" and that it is disclosed "the telephony connection server 150 detects that User B's data network telephone 218 is a party (callee or caller) to the telephone connection." It is further respectfully noted that the disclosure is "[f]or any of the embodiments in FIGS. 3-5, the connection information may also be communicated to the commercial message server 120 to signal the end of the telephone call" so the "commercial message server 120 would then know to discontinue the communication of the commercial messages."

It is respectfully submitted that once "User B's data network telephone 218 is a party (callee or caller) to the telephone connection," User B is "off-hook" and, therefore, the disclosure is related to the display of information when a terminal is in the "off-hook" state. It is further respectfully submitted that the disclosure that the "commercial message server 120 would then know to discontinue the communication of the commercial messages" when "the connection information [is] communicated ... to signal the end of the telephone call," implies that there is no "on-hook" display since there would no longer be any "commercial messages" communicated for display, thereby reinforcing that the disclosure is related to the display of information when a terminal is in the "off-hook" state.

Lastly, the Examiner's attention is directed to col. 21, line 49, to col. 23, line 20. It is respectfully noted that the disclosure is, with respect to FIGS. 6-8, of "methods for providing advertising services on a telephone" and it is disclosed that an "off-hook" status is established, by "determine[ing] the telephone calls that have been established" at "step 502" and "receiv[ing] information including the user identifiers of the parties" at "step 602," prior to any "advertisement services" provided "[a]t step 506" or any "commercial message is sent" to the data network telephone "[a]t step 606." It is respectfully submitted that the establishment of an "off-hook" state prior to providing the "commercial message" or "advertisement services" results in any subsequent display of "commercial message" or "advertisement services" occurring when a terminal is in the "off-hook" state.

In view of the extensive disclosure in Schuster related to the display of information when a terminal is in the "off-hook" state, it is respectfully submitted that there is no suggestion, either implicit or explicit, of displaying the information "regardless of the terminal being on-hook or off-hook," as asserted by the Examiner. It is further respectfully submitted that "the ability to display information when the user terminal is in an 'on-hook' condition" would, therefore, also not be an "obvious variation of Schuster," as asserted by the Examiner. Moreover, it is respectfully submitted that "one of ordinary skill in the art" would not be motivated by the teachings of Schuster to modify the Schuster invention as asserted by the Examiner without the benefit of impermissible hindsight bases upon the disclosure in the Applicant's specification.

It is further respectfully noted that independent claims 1, 10 and 19 have been amended with this paper to further disclose the present invention by reciting that the displayed information is is at least one of an advertisement, a guide and a bulletin. It is respectfully submitted that this limitation further patentably distinguishes the present claims from Schuster in view of the aforementioned remarks.

It is respectfully asserted that independent claims 1, 10 and 19 are allowable over the cited references. It is further respectfully asserted that claims 2 -9, which depend from claim 1, claims 11 -18, which depend from claim 10, and claims 20-22, which depend from claim 19, also are allowable over the cited reference.

CONCLUSION

In view of the above remarks, Applicant submits that claims 1-22 of the present application are in condition for allowance. Reexamination and reconsideration of the application, as originally filed, are requested.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California telephone number (213) 623-2221 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

Lee, Hong, Degerman, Kang & Schmadeka

By: 

Richard C. Salfelder
Registration No. 51,127
Attorney for Applicant

Date: February 6, 2006

Customer No. 035884